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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,283	11/14/2003	Eric Garland	34443.3	2048

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EXAMINER

RAYYAN, SUSAN F

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,283

Applicant(s)

GARLAND ET AL.

Examiner

Susan F. Rayyan

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16, 24-30 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17-23 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16, 24-30 and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-8, 17-23, 31-34 have been withdrawn from consideration.
2. New claims 35-38 have been added.
3. Claims 9-16, 24-30, 35-38. are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 9-12, 15-16, 24-28, 35, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Dutta et al (Pub. No.: US 2002/0138471) and Nair (US 2004/0193900).**

As per independent claim 9 Dutta teaches:

a computer coupled to the network at fig.4, paragraph 70;
a database coupled to the computer at fig.4, paragraph 70 (client rating database);
a query device adapted to request a list of shared files from a plurality of computers connected to the network at paragraph 59, lines 1-4;
and a transfer device adapted to transfer the a list of shared files
from each computer of the plurality of computers to the database at paragraph 60, lines 1-4.

Dutta does not explicitly teach passively and without any action required from any users of the plurality of computers however Nair does teach this limitation at parg.9.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17).

As per claim 10 same as claim arguments above and Dutta teaches:
further comprising an inventory preparation server coupled to the database at paragraph 71(client ratings database) and parg. 77, lines 11-13, rating server.

As per claim 11 same as claim arguments above and Dutta teaches:
further comprising an archiving system coupled to the database, the archiving system to store at least one copy of the plurality of lists at paragraph 71(client ratings database).

As per claim 12 same as claim arguments above and Dutta teaches:
further comprising an inventory processing server coupled to the database at paragraph 71.

As per claim 15 same as claim arguments above and Dutta teaches:
the computer further comprising an interception device adapted to make a copy of a plurality of search requests from the network at paragraph 59.

As per claim 16 same as claim arguments above and Dutta teaches:
the computer further comprising a second transfer device adapted to transfer the plurality of search requests from the computer to the database at paragraph 59.

As per independent claim 24 Dutta teaches:
coupling a computer to a database at fig.4, paragraph 70;
coupling the computer to the network at fig.4, paragraph 70 (client rating database);

locating a plurality of computers connected to the network by IP address at paragraph 71, lines 4-5;

requesting a listing of a library of shared files from each of said plurality of computers connected to the network at paragraph 59, lines 1-4;

and transferring the listing of the plurality of libraries of shared files from the computer to the database at paragraph 60, lines 1-4.

Dutta does not explicitly teach passively and without any action required from any users of the plurality of computers however Nair does teach this limitation at parg.9. It would have been obvious to one of ordinary skill in the art at the tie of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17).

As per claim 25 same as claim arguments above and Dutta teaches:
further comprising adding source information to each of the listings at paragraph 71.

As per claim 26 same as claim arguments above and Dutta teaches:
wherein the source information comprises the geographic location of a computer where the library is stored at paragraph 71.

As per claim 27 same as claim arguments above and Dutta teaches:
further comprising intercepting a plurality of search requests on the network, where said plurality of search requests come to said computer, and copying said plurality of search requests at paragraph 59.

As per claim 28 same as claim arguments above and Dutta teaches:

further comprising transferring the plurality of search requests from the computer to the database at paragraph 59.

As per claim 35 Dutta teaches:

establishing connections to a plurality of computers ... at parg. 6;
requesting a list of files shared by each of the plurality of computers at parg 59 ;
obtaining from each of the plurality of computers the list of files shared by that computer at parg. 59, lines -4;
and storing the obtained plurality of lists of shared files in a database at parg. 71.

Dutta does not explicitly teach a peer-to-peer network. Nair does teach this at parg. 9, lines 1-3. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17).

As per claim 37 Dutta teaches:

a query computer coupled to a network to issue a query to a plurality of peers of ... and to issue a download request to a peer ... at parg.59;
a monitor computer coupled to the network to block the download request from the query computer at parg. 60.

Dutta does not explicitly teach a peer-to-peer network and a database to store a copy of the download request.. Nair does teach this at parg. 9, lines 1-3 and parg.14. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17).

6. Claims 13-14,29-30, 36,38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) and Nair (US 2004/0193900) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 13-14 same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database, an inventory processing server coupled to the inventory preparation server at fig.4. Dutta and Nair do not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

As per claim 29-30 same as claim arguments above and Dutta and Nair do not explicitly teach generating at least one report including data from a plurality of listings and a plurality of search requests however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

As per claim 36 same as claim arguments above and Dutta and Nair do not explicitly teach:
generating a report analyzing the plurality of lists of shared files stored in the database, the report containing a file name, an IP address of a computer from the

plurality of computers that provided the file name in its list of shared files, and at least one of: a file format, a file creation date, a user identifier, an internet service provider (ISP), and a geographical location of the computer. O'Kane does teach this at parg. 62-63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

As per claim 38 same as claim arguments above and Dutta and Nair do not explicitly teach:

an inventory processing computer coupled to the database to add information to the copy of the download request in the database and a report preparation server to prepare a report based on information in the database. O'Kane does teach this at parg. 62-63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

Response to Arguments

7. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

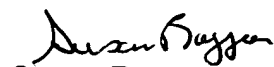
Examiner points out the After Final filed on April 6, 2005 presented arguments which were addressed by the Examiner however the Amendment was not entered as it raised new issues.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan F. Rayyan whose telephone number is 571-272-4117. The examiner can normally be reached on M,T,H (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susan Rayyan
August 31, 2005


Primary Examiner
Art Unit 2167